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EXAMINER
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TRAN LIEN, THUY

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1761

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/778,470  
Filing Date: February 07, 2001  
Appellant(s): STEVENS ET AL.

**MAILED**  
**JUL 12 2007**  
**GROUP 1700**

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Todd Van Thomme  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 3/5/07 appealing from the Office action  
mailed 10/3/06

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 49-81, 83-110. Claim 111 is not on appeal.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**GROUND OF REJECTION NOT ON REVIEW**

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief.

The 102 rejection of claim 111 as being anticipated by Baur et al.

The obviousness double patenting rejection of claims 49-81, 83-11 over claims 1,3,4-5,10-37,40-56,69-70 of co-pending application 10/170964.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

WO 94/21143

BAUR et al

9/1994

**NEW GROUND(S) OF REJECTION**

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 49-51, 53-57, 61-63, 78-81, 83-85, 88-94, 101-103, 111 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Baur et al ( WO 94/21143)

Baur et al disclose a coating composition comprising wheat flour, modified corn starch or modified potato-based starch, rice or corn flour, dextrin, gum, leavening agent and calcium salts. The amount of wheat flour is from about 5-50%. The amount of corn or potato starch is in the range of 5-50%. The rice or corn flour is used in the range of 2-50%. Dextrin is used in amount of about 2-20%. Leavening agents are used in amount of .1-2.5 for sodium bicarbonate and .1-3.5% for leavening acids such as sodium acid pyrophosphate. Calcium sat is used in amount of .1-1.5%. Gum, such as xanthan gum or methylcellulose, is used in amount of .1-5%. The dextrin used includes corn dextrin, rice dextrin or a tapioca dextrin. The composition also includes about 2-

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20% protein such as whey protein. The composition can be used in any food substrate which can be coated and frozen or coated, cooked, frozen or chilled and subsequently reheated or fully cooked by frying, baking or microwaving. The potential substrates include vegetables such as potato. After the substrate is coated, it may be chilled, frozen or par or fully cooked. The dry mixture of the components of the composition are mixed with water in the weight ration of 10 parts solids to 7-20 parts water. As an alternative procedure, the dry mixture of components can be applied in dry form to a moist substrate surface. The coated French fries product exhibit similar textural properties as before exposure to the lamp after standing form 15-30 minutes under standard restaurant infrared heating lamps. ( page 3, table 1, page 5 lines 6-35, page 6 lines 8-20, page 8 , page 9 lines 6-26 and the examples)

Baur et al disclose all the limitations of the cited claims. Since the composition include modified potato starch or corn starch, rice flour or corn flour, Baur et al disclose embodiment in which the composition includes modified potato starch and rice flour. The amounts of rice flour and dextrin falls with the ranges claimed; thus, it is inherent the ratio also falls within the ranges claimed. However, if it is not inherent, it would have been obvious to one skilled in the art to select various ratios within the range of flour and dextrin disclosed by the reference depending on the type of coating and properties wanted. For example, it would have been obvious to use equal proportion of dextrin and flour, a ratio of 1:1 if one wants equal contribution of properties from both component of rice flour and dextrin.

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Claims 52,58-60,64-77,80,86-87,95-100,104-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baur et al.

Baur et al do not disclose the potato starch is modified ungelatinized low-amylose content potato starch, the dextrin is low soluble or high soluble, adding sugar, conditioning the substrate, the type of rice flour as claimed, holding the substrate and then reheating, the means of holding as in claims 105-106, finish cooking after coating without freezing.

In absence of showing of criticality of unexpected result, it would have been obvious to one skilled in the art to select any type of potato starch. Raw potato starch is well known in the art and it would have been obvious to one skilled in the art to select it as the source of potato starch. Potato starch is not high in amylose content and the claims do not define what will constitute low amylose. It would have been obvious to one skilled in the art to add sugar when desiring to sweeten the composition; the amount used depends on the degree of sweetness desired and would have been obvious to one skilled in the art. It would have been obvious to choose the solubility of the dextrin depending on the type of coating mix. For example, if a slurry is made, it would have been obvious to choose high solubility dextrin so that it can dissolve quickly or if a dry mix is made, it would have been obvious to choose low solubility dextrin so that it is not affected easily by moisture. It would have been obvious to blanch the substrate in water when the food is potato because it is a common step in preparing potato product. It would have been obvious to freeze or not freeze the product depending the time of consumption of the product after it is coated. If the product will be consumed in a short

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time after coating, then it is obvious freezing is not needed. It would have been obvious to freeze the product without parfrying when uncooked product is wanted. It would have been obvious to hold the coated food for any amount of time depending on the time of consumption. It would have been obvious to hold the food at ambient temperature or under heat depending on the temperature wanted in the product. If it is desired for the food not to be hot, it would have been obvious to hold it under ambient temperature or vice versa. It would have been obvious to use any type of rice flour depending on the taste and flavor desired. This would have been a matter of preference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 49-81, 83-111 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3,4-5,10-37,40-56, 69-70 of copending Application No. 10/170964. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the co-pending application is directed to coating compositions comprising rice flour, dextrin and modified potato starch. The difference resides in the types of food substrates that the coating compositions are used in. However, such difference is not patentably distinct because it would have been obvious to one skilled in the art to use the coating composition on the food substrates claimed in the co-pending application to obtain the benefits provided by the coating compositions. It would also have been obvious to add wheat flour when desiring to adjust the viscosity and texture of the composition. It would have been obvious to add emulsifier to aid in dispersing the slurry. The additive is well known in the art to be used for such purpose.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### **(10) Response to Argument**

On page 23 of the appeal brief, appellant argues the Baur et al reference is extraordinarily broad and that any of the number of combination is possible including those that is outside of the claimed invention. This argument is not persuasive. Appellant's argument is correct up to the point that Baur et al do disclose embodiment that contains corn starch and corn flour. However, the Baur et al disclosure also includes composition comprising rice flour, dextrin and modified potato starch. This is



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explicitly disclosed in Baur et al. All embodiments in the reference must be taken into consideration. The fact that Baur et al discloses other embodiment is not an issue as long as they disclose embodiment which meets the claimed limitations.

Appellant further argues Baur et al do not anticipate the claims because the claimed subject matter must be disclosed in the reference with sufficient specificity to constitute an anticipation. Appellant states the reference does not indicate with sufficient specificity the critical ratio of rice component to dextrin component. This argument is not persuasive. The reference specifically teaches that the amount of rice flour is from 2 to 25% or 5-50 and the amount of dextrin is 2-20; thus the combined amount of dextrin and rice flour can be 4-45 in one embodiment and 7-70 in another embodiment. Both the end points of the two embodiments are within the range claimed and the points in between the two ends are within the range claimed. If the amounts are the same, then, it is inherent the ratio also is the same. For example, if the rice component is 10% and the dextrin is 20%, then the ratio is 1:2 and the combined amount is 30; both falls within the ranges claimed. In any event, it would have been obvious to one skilled in the art to select various ratios within the range of flour and dextrin disclosed by the reference depending on the type of coating and properties wanted. For example, it would have been obvious to use equal proportion of dextrin and flour, a ratio of 1:1 if one wants equal contribution of properties from both component of rice flour and dextrin.

On page 24 of the appeal, appellant makes the same argument with respect to claims 55-57, 61-63. The argument is not persuasive for the same reason set forth above.

On pages 25-27 of the appeal brief, appellant makes reference to the fourth declaration made by John Stevens. The declaration states that the ratio of rice to dextrin gives unexpected result with respect to overall hedonic score, crispness, toughness, tooth compaction and Munsell Color. The declaration is not found to be persuasive to overcome the rejection. The declaration fails to make any comparison between the claimed invention and the prior art. There is no comparative data between the coating and method as claimed versus the coating and the method disclosed in Baur. Baur et al disclose a coating containing the same percentage of rice flour and dextrin as claimed. Furthermore, the declaration is not commensurate in scope with the claims because the data shown is only to potato product. The coating composition as claimed is not directed to any specific substrate and the method as claimed is directed to any food substrate, not just potato.

Appellant makes the same argument as above with respect to claims 58-60, 64-72. The argument is not persuasive for the same reason set forth above.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

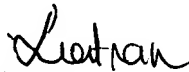
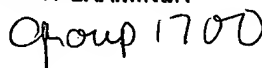
(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

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Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Lien Tran

  
LIEN TRAN  
PRIMARY EXAMINER  


**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**

Conferees:

  
Keith Hendricks

  
Greg Mills

  
W. Kaynski

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